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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|------------------------|---------------------|------------------|
| 10/568,065  | 02/13/2006  | Rudolf Nenno           | 2003P12881WOUS      | 8084             |
| 27799 7590 12/22/2010<br>COHEN, PONTANI, LIEBERMAN & PAVANE LLP<br>551 FIFTH AVENUE<br>SUITE 1210<br>NEW YORK, NY 10176 |             |                        |                     |                  |
| EXAMINER<br>AVERY, BRIDGET D  |             |                        |                     |                  |
| ART UNIT<br>3618  |             | PAPER NUMBER           |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/568,065

**Applicant(s)**

NENNO ET AL.

**Examiner**

BRIDGET AVERY

**Art Unit**

3618

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-22 and 24-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-22 and 24-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-942)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 20-22 and 24-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakao (US Patent 6,856,866).

Nakao teaches an apparatus and method for controlling energy consumers/load on an energy accumulator (battery 5), the method including the steps of measuring at least one parameter that characterizes the state of charge of the battery (5), transmitting the parameter to a control unit (11), generating by the control unit a control signal as a function of the parameter, the control signal via the control unit (11) controls energy consumptions that are connected directly or indirectly to the battery (5) and calculating by the control unit (11) the energy consumption of the consumers/load on a planned

route in advance. Re claim 21, the battery has a positive energy balance at the time of the control signal. Re claim 22, the system includes an ambient temperature sensor and a battery condition detecting device. See Fig 2 and elements (114, 115 and 116). Re claim 23, see the high discharge execution determining section (124). Re claim 24, the system includes a signal. The teaching of a visual display is suggested in col. 4, lines 21-27. Re claims 25 and 26, see the system controller (9).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 20-22 and 24-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitagawa et al. (US Patent 5,426,589) in view of Nakao (US Patent 6,856,866).

Kitagawa et al. teaches an apparatus and method for controlling energy consumers/load (1) on an energy accumulator (battery), the method including the steps of measuring at least one parameter that characterizes the state of charge of the battery, transmitting the parameter to a control unit (6), generating by the control unit a control signal as a function of the parameter, the control signal (W) via the control unit (6) controls energy consumptions that are connected directly or indirectly to the battery and calculating by the control unit (6) the energy consumption of the consumers/load (1) on a planned route in advance. Re claim 21, the battery has a positive energy balance

at the time of the control signal. Re claim 22, the system includes an ambient temperature sensor and a battery condition detecting device. See Figs. 2, 3A and 3B. See also col. 2, lines 15-35. Re claim 22, see col. 4, lines 62-68. Re claim 24, the system includes a display device (8) to inform a driver. See col. 5, lines 1-9. Re claims 25 and 26, see col. 1, lines 31-64, col. 5, lines 10-67 and col. 6, lines 1-7. Re claim 28, the control signal (P) sent to the electrical load control device (6), meets applicant's claimed "remote data transmission module".

Nakao teaches a data mask defined by a high discharge execution determining section that receives output data based on estimates. The high discharge execution determining section carries out prioritization, filtering and normalization of different data formats.

Based on the teachings of Nakao, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to add a data mask to the system of Kitagawa et al. prevent overdischarge of the battery. Re claims 36 and 37, where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly, Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the

combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396. Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement. The provision of a wire-free or a wire-based load controller would have been obvious to one having ordinary skill in the art since both are old and well known for connecting control devices and for transmitting information to and from control devices.

3. Claims 25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitagawa et al. ('589) and Nakao ('866) and applied to claim 21 above and further in view of Kuroda et al. (US Patent 6,314,347).

The combination of Kitagawa et al. and Nakao lack the teaching of actuators connected to the control unit by means of which engine parameters can be adapted.

Kuroda et al. teaches actuators connected to the control by means of which engine parameters can be adapted.

Based on the teachings of Kuroda et al., it would have been obvious to one having ordinary skill in the art, at the time the invention was made to modify the combination of Kitagawa et al. and Nakao and add actuators to the control unit to

regulate engine parameters to minimize fuel consumption of the engine to extend the distance the vehicle can travel on the battery charge.

***Response to Arguments***

4. Applicant's arguments filed April 21, 2010 have been fully considered but they are not persuasive. Contrary to applicant's arguments, Nakao (US Patent 6,856,866) teaches the claimed data mask. Nakao clearly teaches "the control section controls high discharge without power assist limit to the vehicle in the route before (i.e. in advance) a downhill travel path of the route based on the route information output from the car navigation apparatus/module. As broadly claimed, the features defined by applicant's claims are clearly met by Nakao ('866). Further, the features taught by Kitagawa also teaches applicant's claimed "data mask". Kitagawa clearly teaches a residual capacity detecting device (4) which measures the state of charge of the electrical source/battery (3); a load control signal (P), see col. 5, lines 1-5; calculating by arithmetic device 5. Re claim 22, see col. 4, lines 62-68. Re claims 25 and 26, see col. 1, lines 31-64, col. 5, lines 10-67 and col. 6, lines 1-7.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "filter 9 comprises a data mask that prioritizes the data from modules 1-8. The filter adapts and filters the data with respect to data format. Information is assessed and weighed in advance by filter 9 based on importance of the data with respect to the driver, road way, vehicle, energy sources, energy sinks, and the like, to achieve a processing time in logic module 12 that is as short as possible") are not recited in the

rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIDGET AVERY whose telephone number is (571)272-6691. The examiner can normally be reached on Monday-Thursday from 9:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Allen Shriver, can be reached on 571-272-6698. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Bridget Avery/  
Examiner, Art Unit 3618

/J. ALLEN SHRIVER II/  
Supervisory Patent Examiner, Art Unit 3618